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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,744	08/24/2006	Devan Govender	05-713	6074
20306 7590 06/23/2010 MCDONNELL BOEHNNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
AHMED, MASUD				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/550,744

Applicant(s)

GOVENDER ET AL.

Examiner

MASUD AHMED

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/12/2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 11-15, 17-26, 28-32, 34-42 and 45-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45-49 is/are allowed.
- 6) ☒ Claim(s) 9, 11-15, 17-26, 28-32, 34-42 and 50-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant has amended claims 9, 26 and 45, 50. Examiner has considered amendment to the claims very carefully and addressed them below.

Interview

An interview was initiated by the examiner on 6/08/2010 with Mr. Richard A. Machonkin with the proposed amendment to overcome the 101 issues with an examiner amendment, an agreement was reached, however upon close review of the claims, the claimed subject matter is not found to be patentable, therefore examiner has not entered the amendment that was proposed and agreed upon.

Response to Arguments

Applicant's arguments filed on 03/12/2010 have been fully considered but they are not persuasive. Examiner has respectfully disagreed with the applicant at least for the following.

1. Examiner has addressed the amended portions of the claims respectively.
2. In response to the applicant's argument on "immediate usage of credits and play through requirement" is addressed through the newly discovered art Muskin (US 7, 341, 518) below.

3. In response to the applicant's argument on "player's sub-account", examiner respectfully disagrees because Brosnan clearly teaches player's cashable and non-cashable credits are tracked and monitored on col 10 lines 20-51.
4. In response to the applicant's argument on claims 45 and 50, examiner has indicated the allowable subject matter below.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 26 and 50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The methods recited in these claims include the judicial exception of an abstract idea (a method administering promotion and method of computing player account balance). No physical transformation is present to establish a practical application of the abstract idea.

As explained in the Interim Guidelines in view of *In re Bilski*, the first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products," while a "process" consists of a series of steps or acts to be performed. For purpose of 101, a "process" has been given a specialized, limited meaning by the courts.

Based on Supreme Court precedent¹ and recent Federal Circuit decision, the Office's guidance to examiners is that a 101 process (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. ***This is called "machine-or-transformation test"***. If neither of these is met by the claim, the method is not a patent eligible process under 101 and should be rejected as being non-statutory subject matter.

For example all the steps recited in this claim do not positively tie to a machine, computer or a processor, therefore fails to meet the requirement of "machine or transformation" test. A method claim needs positive recitation of machine or computer implemented method and how they are being implemented step by step

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the claims to recite **"until a play-through requirement has been met"**, however it is unclear to the examiner, what exactly applicant has meant by "until a play through requirement has been met",

what exactly the requirement or play through requirement of what element is seems to be missing in the claims. A clarification of claimed language is respectfully requested.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 9, 11-15, 17-26, 28-32, 34-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acres (U.S. 6712697), in view of AAPA (applicant's admitted prior art), view of Brosnan et al (7,063,617), further in view of Muskin (US 7,341,518).

Regarding claims 9 and 26, Acres discloses a system for administering promotions associated with a wagering application in which a player purchases credit to make wagers on a game of chance (Col 4, Lines 35-55). Acres disclose:

a credit administration facility operable to maintain a credit account for the player wherein the credit administration facility is operable to automatically determine the balance of the credit account of the player as a function of any credit purchases made by the player, wagers made by the player and their corresponding payouts, and any a priori promotion credit awarded to the player (Col 6, Lines 62-67; Col 7, Lines 1-7), it should be noted that the priori credit is awarded to the players immediately to be wagered on the machine (abstract) , the credit administration facility being instruct able to display the balance of the credit account to the player on a display means (Figure 2; Col 7, Lines 1-7), wherein the credit administration facility is further operable to maintain a non cashable sub account corresponding to a portion of the player's credit account that is not redeemable for monetary value and to maintain at least on play through sub account for the player (Col 9, Lines 63-67; Col 10, Lines 1-9). Acres specification clearly discloses the following on col 5, line 60-col 6 line 14:

"One way in which account credits may be applied to a player's account is as an **incentive to open the account**. In other words, when the account is opened by the casino, an account credit, e.g., \$5, is applied to the account. The following Table 1, which is described in more detail below, sets forth the sequence followed by the player to redeem the account credits for play on EGM 12.

(1) TABLE 1 1. Player account information, including account credits and points, is stored in MCI 50 RAM responsive to

insertion of card 66 into reader 60. 2. Player places wager by inserting bill into bill acceptor 68 or coin into the coin acceptor (not shown). 3. Player plays game by pushing spin button 53. 4. Responsive to play, the account credits are automatically debited in the amount of the wager and applied to credit meter 70. 5. Steps 3 and 4 are repeated so long as the player wishes to play. 6. When the player is finished playing, he or she pushes cash-out button 74 and withdraws card 66 from reader 60."

Which means players purchase the credit to receive incentive or a priori promotion credit in very similar way applicant's claim of " a player purchase credit to make wagers on a game of chance and can use a priori promotion credit awarded to the player to make wager..." by giving the claim it's broadest reasonable interpretation. Further more applicant has disclosed the following in the background of the application:

"It is usual for this promotion credit given to the player to be a percentage of the amount of credit purchased by the player. The promotion credit is intended for use by the player to wager on games of chance or skill offered by the online casino. **This type of credit is available to the player for immediate use for wagers** and will be termed, for convenience, as a priori promotion credit." Therefore the limitation as admitted by the applicant in the background of the application would have been within the knowledge of ordinary skilled artisan at the time of invention.

However Acres is silent on disclosing non-cashable sub-account, from the disclosure of Acres we can make the determination that Acres makes distinction of player's cashable credits and non-cashable credits such as comp points that can be used towards meals or entertainment. Brosnan an art of record discloses wins of restricted or non-cashable credits in a game machine, where he discloses on col 10 lines 20-51 how the cashable

and non-cashable credits are allocated into the separate accounts for the players (see FIG 4); Brosnan discloses cashable credit and non-cashable credits, however is silent on disclosing a play through requirement for the non-cashable credits to be cashed out, Muskin teaches a wagering game system with the casino comp system where players have to meet a play-through requirement before they can cash-out the restricted or "on-cashable credits (col 5, lines 43-48), a promotional credit is immediately available for players to wager without condition (col 10, lines 22-27); therefore it would have been obvious to ordinary skilled artisan at the time of invention to separate the accounts to segregate cashable points or credits from non-cashable credits or points so that the casino and the player can easily make the distinction over players available credits for cashing out and adapt a requirement of Muskin's teaching of play-through requirement in order for players to cash-out non-cashable credits.

Regarding claims 11, 28, in which the credit administration facility is instruct able to display a balance of the non cashable sub account to the player on the display means (Figure 2; Col 7, Lines 3-7).

Regarding claim 12, 29, in which the credit administration facility detects the award of a priori promotion credit to the player, the priori promotion credit having a corresponding quantum and a corresponding play through multiplier (Col 7, Lines 14-26; Col 8, Lines 1-23). The credit administration facility gives a bonus in form of credit to the account credits. Since the account credits must be

wagered before they are cashed out, though not specifically cited, it would be obvious to one of ordinary skill in the art that a play through multiplier or requirement is inherent.

Regarding claims 13, 14, 17, 18, 19, 24, 25, 30, 31, 34, 35, 36, 41, 42 in which the credit administration facility increments a balance of the player's non cashable sub account by the quantum of the priori promotion credit (Figure 2; Col 7, Lines 3-7), and in which the at least on play through sub account for the player includes a play through sub account and a play through achieved sub account (Col 9, Lines 63-67; Col 10, Lines 1-9). It would have been obvious to one of ordinary skill in the art that although the account credit is not split into further sub accounts, it is functionally equivalent as there is no further benefit of the sub accounts other than to keep track of the non cashable credits.

Regarding claim 15, 32, in which the credit administration facility is instruct able to display a balance of the at least one play through sub account to the player on the display means (Figure 2; Col 7, Lines 3-7).

Regarding claim 20, 37, in which the credit administration facility debits the balance of the player's credit account and the balance of the non cashable sub account with the size of the wager and credits these balances with a payout arising from the wager if successful (Col 6, Lines 62-67; Lines 7, Lines 1-7).

Regarding claim 21, 38, in which the credit account facility clears the balances of the play through required the play through achieved sub accounts when the size of the wager exceeds the balance of the non cashable sub account. It would have been obvious to one of ordinary skill in the art that the balance of the account credit would be cleared if the wager exceeds the balance since the account credit is debited (Col 6, Lines 62-67; Lines 7, Lines 1-7).

Regarding claim 22, 39, in which the credit administration facility enables the player to request a cash out at any time (Col 4, Lines 57-59).

Regarding claim 23, 40, in which the credit administration facility automatically determines, in response to the player's cash out request, a balance of the player credit account that is redeemable for monetary value and displays the redeemable balance to the player on the display means (Figure 2; Col 4, Lines 60-67).

Allowable Subject Matter

3. **Claims 45-49** allowed.
4. **Claims 50-54** would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.
5. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach a peer-to-peer service where house does

not act as a banker but levies a transaction fees for the players and the cashable credit amount is achieved through a play through requirement of promotional non-cashable credits.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MASUD AHMED** whose telephone number is (571)270-1315. The examiner can normally be reached on **Mon-Fri 10:00am-7:00pm, Alt Fri, EST**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571 272 4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A./
Examiner, Art Unit 3714

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714